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Filing date: **12/21/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer information

Name	DAMM, LLC
Granted to date of previous extension	12/22/2021
Address	3940 NIAGRA LANE PLYMOUTH, MN 55446 UNITED STATES
Attorney information	PAUL DIETZ DIETZ LAW OFFICE LLC 4975 WILDERNESS LAKE CIR ELKO NEW MARKET, MN 55020 UNITED STATES Primary email: paul@dietzlawoffice.com 9522012008
Docket no.	2021_07551

Applicant information

Application no.	90453221	Publication date	08/24/2021
Opposition filing date	12/21/2021	Opposition period ends	12/22/2021
Applicant	WRB, Inc. 5865 NEAL AVE N / #113 STILLWATER, MN 55082 UNITED STATES		

Goods/services affected by opposition

Class 028. First Use: 1999/02/26 First Use In Commerce: 1999/02/26
All goods and services in the class are opposed, namely: Equipment sold as a unit for playing parlor games

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)
The mark is generic	Trademark Act Sections 1, 2 and 45
The mark comprises matter that, as a whole, is functional	Trademark Act Section 2(e)(5)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not	Trademark Act Sections 1, 2 and 45; and Section

acquired distinctiveness	2(f)
Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
Deceptiveness	Trademark Act Section 2(a)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Mark cited by opposer as basis for opposition

U.S. registration no.	6230202	Application date	05/08/2020
Register	Principal		
Registration date	12/22/2020	Foreign priority date	NONE
Word mark	MINNESCHLAGEN		
Design mark			
Description of mark	NONE		
Goods/services	Class 028. First use: First Use: 2020/07/01 First Use In Commerce: 2020/07/01 Equipment sold as a unit for playing action skill games involving a stump, nail-and hammer; Party games		

Attachments	88907094#TMSN.png(bytes) Notice of Opposition_against_hammerschlagen_12212021.pdf(154675 bytes)
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Signature	/Paul Dietz/
Name	PAUL DIETZ
Date	12/21/2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No.: 90/453,221

For the mark: Hammer-Schlagen

Published in the Official Gazette of August 24, 2021

DAMM, LLC

Opposer,

Opposition No. _____

WRB, Inc.

Applicant.

NOTICE OF OPPOSITION

Opposer, DAMM LLC (“Opposer” or “DAMM”), believes that it will be damaged by registration of the mark shown in U.S. Application Serial No. 90/453,221, and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a limited liability company organized and existing under the laws of Minnesota, having a current registered office at 3940 Niagara Lane N., Plymouth, MN 55446. Opposer has continuously marketed and sold as a unit a hammer, nail and wood (stump) game (equipment sold as a unit that is usable both outdoors and/or as a parlor game) in interstate commerce while using the mark MINNESCHLAGEN as a source identifier of those games since at least as early as July 1, 2020.
2. In addition to its common law trade mark rights in the mark MINNESCHLAGEN, on or about May 8, 2020 DAMM LLC filed a federal trademark application seeking to register the mark MINNESCHLAGEN in international class 028 for parlor games, and

equipment sold as a unit for playing stump, nail and hammer games. The application was assigned serial no. 88/907,094.

3. On or about December 22, 2020 the United States Patent and Trademark Office granted DAMM United States Trademark Registration 6,230,202 which corresponds to application serial no. 88/907,094. This registration is valid and subsisting.

4. The word hammerschlagen is the common, everyday name for a game that is played by the public using hammer, nails, and wood (stump, log, board, etc.).

5. The word hammerschlagen is the common, everyday name for the combination of hammer, nails, and wood (stump, log, board, etc.) that may be used as an indoor game (parlor game).

6. Many “do-it-yourselfers” and the consuming public assemble hammer, nail, and wood (a log, stump, board, wood block, etc.) together and refer to this assembly as a hammerschlagen game.

7. The word “hammer” describes a component of a hammer, nail and wood parlor game and the word schlagen describes the action used when playing the hammer, nail and wood game.

8. Notwithstanding Opposer’s prior rights in and to the mark MINNESCHLAGEN, on January 7, 2021 WRB, Inc. (“Applicant”) filed U.S. Application Serial No. 90/453,221 seeking registration of the word Hammer-Schlagen for “equipment sold as a unit for playing parlor games” in international class 028 alleging use in commerce at least as early as February 26, 1999.

9. Applicant has not been granted any prior trademark registrations that designate “equipment sold as a unit for playing parlor games” as the designated goods.

10. Applicant is allegedly selling hammer, nails and wood as a unit (kit) and using the generic word hammerschlagen to identify those goods.

11. The specimens submitted with U.S. Application Serial No. 90/453,221 illustrates that the equipment allegedly sold by applicant is a hammer, nail and stump.

12. Applicant has applied to register a mark for goods that are the same or similar to those goods identified in U.S. Trademark Registration 6,230,202.
13. Notwithstanding Opposer's prior rights in and to the mark MINNESCHLAGEN, on or about August 23, 2021 Applicant filed a Complaint in the United States District Court, District of Minnesota seeking, among other things, to cancel United States Trademark Registration 6,230,202 (case number 21-cv-1899 NEB/TNL).
14. Applicant alleges in case number 21-cv-1899 NEB/TNL that it's use of the word Hammer-Schlagen as a source identifier for entertainment services should cancel Opposer's rights in the mark MINNESCHLAGEN used as a source identifier for goods.
15. Applicant alleges in case number 21-cv-1899 NEB/TNL that there is a likelihood of confusion between use of the word Hammer-Schlagen as a source identifier for entertainment services and use of the mark MINNESCHLAGEN as a source identifier for hammer, nail, and wood games.
16. Contrary to the declaration made in U.S. Application Serial No. 90/453,221, Applicant is aware of Opposer's priority trademark rights and has not withdrawn it's application.
17. Contrary to the declaration made in U.S. Application Serial No. 90/453,221, on information and belief, Applicant has not used continuously in interstate commerce the word Hammer-Schlagen as a source identifier of equipment sold as a unit for playing parlor games.
18. Contrary to the declaration made in U.S. Application Serial No. 90/453,221, on information and belief, Applicant did not use in interstate commerce the word Hammer-Schlagen as a source identifier of equipment sold as a unit for playing parlor games until some time after May 8, 2020.
19. Contrary to the information provided by Applicant in U.S. Application Serial No. 90/453,221, on information and belief, Applicant has not used the word Hammer-Schlagen as a source identifier of any goods sold in the ordinary course of trade in interstate commerce prior to May 8, 2020.

20. Contrary to the information provided by Applicant in U.S. Application Serial No. 90/453,221, on information and belief, Applicant has not sold in the ordinary course of trade in interstate commerce any “equipment sold as a unit for playing parlor games” prior to May 8, 2020.

21. Contrary to the information provided by Applicant in U.S. Application Serial No. 90/453,221, Applicant has not continuously used the word Hammer-Schlagen as a source identifier of any goods sold in the ordinary course of trade in interstate commerce from February 26, 1999.

22. Contrary to the information provided by Applicant in U.S. Application Serial No. 90/453,221, Applicant has not continuously sold in the ordinary course of trade in interstate commerce any “equipment sold as a unit for playing parlor games” from February 26, 1999.

23. U.S. Registration Number(s) 2405337, 4804117, 5548112 are service mark registrations.

24. U.S. Registration Number(s) 2405337, 4804117, 5548112 do not designate “equipment sold as a unit for playing parlor games” as registered goods.

25. The entertainment services designated in U.S. Registration Number(s) 2405337, 4804117, 5548112 may be provided without the use of “equipment sold as a unit for playing parlor games.”

FIRST CLAIM FOR RELIEF

The word hammerschlagen is a generic word for a beer drinking game

26. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 25 inclusive as if fully set forth herein.

27. The applied for word “hammer-schlagen” is a word that is used by the public as a common, everyday name for a beer drinking parlor game.

28. The words hammer and schlagen are descriptive of the components and actions of a beer drinking parlor game.

29. The words hammer and schlagen describe the function of the goods Applicant is allegedly selling.

30. Opposer and the public will be damaged and harmed if Applicant is granted registration to a generic and descriptive mark.

31. Opposer will be damaged by registration of Applicant's mark as shown in the Opposed application because registration will give Applicant prima facie evidence of its ownership of, and its exclusive nationwide right to use, a word that is descriptive and generic for the game that it allegedly sells.

SECOND CLAIM FOR RELIEF

Likelihood of confusion – DAMM is senior user

32. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 31 inclusive as if fully set forth herein.

33. Applicant has asserted that the word hammer-schlagen as shown in the Opposed application so resembles Opposer's mark MINNESCHLAGEN as to be likely, when used on or in connection with the goods identified in the Opposed application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

34. Applicant has not sold continuously in the ordinary course of trade in interstate commerce any "equipment sold as a unit for playing parlor games", prior to May 8, 2020 and thus is a junior user of its mark.

35. Opposer will be damaged by registration of Applicant's mark as shown in the Opposed application because registration will give Applicant prima facie evidence of its ownership of, and its exclusive nationwide right to use, a word that it has asserted is likely to be confused with the mark MINNESCHLAGEN as shown in Opposer's registration.

THIRD CLAIM FOR RELIEF

Fraud

36. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 35 inclusive as if fully set forth herein.

37. Applicant was aware at the time of filing Applicant's application that the public uses the word "hammer-schlagen" as a common, everyday name for a parlor game.

38. Applicant has provided deceptive misinformation and misleading information in Applicant's application in an attempt to obtain a registration to the generic word hammer-schlagen.

39. Applicant used U.S. service mark registrations 2405337, 4804117, 5548112, in furtherance and to perpetrate a fraud on the Trademark office. As such, these registrations should be invalidated.

40. Opposer will be damaged by registration of Applicant's mark as shown in the Opposed application because registration will give Applicant prima facie evidence of its ownership of, and its exclusive nationwide right to use, a word that is descriptive and generic for a game that Applicant has not sold continuously in the ordinary course of trade in interstate commerce from February 26, 1999.

WHEREFORE, Opposer believes and avers that it will be damaged by Applicant's application for registration and respectfully requests that the Opposition be sustained and registration of the mark shown in Application No. 90/453,221 be refused, and grant all other relief to Opposer as it deems just.

Dated: December 21, 2021

Respectfully Submitted

s/ Paul Dietz

Paul T. Dietz (#237838)

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